

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN A. TURNER

Appeal No. 2002-1591
Application 09/616,503

ON BRIEF

Before COHEN, FRANKFORT, and MCQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 35 through 40, 42, 44 through 55, 57 and 59 through 72, all of the claims remaining in this application. Claims 1 through 34, 41, 43, 56 and 58 have been canceled.

Appellant's invention is directed a window shutter system and method for assembling such a window shutter system.

Independent claims 35, 50, 67 and 72 are representative of the Application subject matter on appeal and a copy of those claims can be found in Appendix A of appellant's brief.

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The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Turner '858	5,307,858	May 3, 1994
Richter et al. (Richter)	5,722,477	Mar. 3, 1998

Claims 35 through 40, 42, 44 through 55, 57 and 59 through 72 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Richter.

Claims 48 and 65 additionally stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Turner '858 in view of Richter.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the final rejection (Paper No. 7, mailed May 10, 2001) and examiner's answer (Paper No. 14, mailed January 18, 2002) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 13, filed November 20, 2001) and reply brief (Paper No. 15, filed February 15, 2002) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

As a preliminary matter, we note that appellant in both the brief and reply brief has requested entry of the amendment after final filed July 17, 2001 (Paper No. 8) and urged that the changes in such amendment be considered on appeal. The examiner refused entry of the above-noted amendment in an advisory action mailed August 1, 2001 (Paper No. 9). The non-entry of amendments during prosecution of an application before the examiner relates to petitionable subject matter under 37 CFR § 1.181, and is not an appealable issue. Under 35 U.S.C. § 134 and 37 CFR § 1.191 appeals may be taken from the decision of the primary examiner to reject claims. This Board does not and is not empowered to exercise general supervisory authority over the Examining Corps. See, for example, In re Hengehold, 440 F.2d 1395, 1404, 169 USPQ 473 (CCPA 1971) and In re Mindick, 371 F.2d 892, 894, 152 USPQ

566, 568 (CCPA 1967). Accordingly, we make no further comment regarding the amendment that was refused entry by the examiner.

Turning to the examiner's rejection of claims 35 through 40, 42, 44 through 55, 57 and 59 through 72 under 35 U.S.C. § 103(a) as being unpatentable over Richter (final rejection, pages 2-3), we note that the examiner has determined that Richter discloses all of the elements of appellant's claims on appeal except for "the hinge, the connector being made of plastic, and the steps of the method claim in the order recited." To account for these differences, the examiner urges that 1) "it is inherent that the joint 155 [Fig. 11] permits pivotal movement between the frame members due to the materials and structures involved;" 2) it would have been obvious to form the connectors (9) of Richter of plastic because such "would most efficiently accomplish the goals of the device;" and 3) with regard to the two steps of method claim 67, "such would have been the obvious method of assembling the Richter et al device."

Unlike appellant's claimed window shutter system, Richter addresses a connector assembly arrangement for connecting plastic pipe sections (2) together in a locked arrangement to define

interconnected frames (3) that can support panels (4) and wherein a plurality of panels/frames can be joined together to form an enclosure or room divider (col. 1, lines 21-25). See, for example, Figures 1A-1C. The examiner has not addressed the fact that appellant's claimed subject matter (e.g., independent claims 35, 50 and 72) is directed to a window shutter system, while the Richter patent addresses frames or panels for a room divider. As for the examiner's contention that the double claw clip (155) of Richter is readable as a "hinge" because it permits pivotal movement between adjacent frame members, we would generally agree. However, what the examiner has failed to account for in claim 35 on appeal is the further limitation that such "hinge" is structurally and functionally "operable to connect one of the elongate members to a window frame." In appellant's window shutter system it is the elements (120), (216), (118) and (218) which define a hinge operable to connect one of the elongate members (126a) to a window frame member (110).

In the pipe connector assembly and room divider of Richter, the double claw clip (155), seen best in Figure 11, is described as holding two parallel pieces of pipe together and being used to stabilize and join one panel to an adjacent panel (col. 7, lines

40-47). Such double claw clips (un-numbered) appear to be shown in Figures 1 and 2 of Richter adjacent the connector fitting assemblies (5) at the upper and lower corners of adjacent frames (3). As urged by appellant in both the brief and reply brief, it is immediately apparent that the double claw clip (155) of Richter is not a "hinge" which is "operable to connect one of the elongate members to a window frame," as required in claim 35 on appeal. Moreover, we agree with appellant that it would not have been obvious to modify the double claw clip (155) to do so. For those reasons, we will not sustain the examiner's rejection of claim 35 under 35 U.S.C. § 103(a) based on Richter. It follows that the examiner's rejection of claims 36 through 40, 42 and 44 through 49, which depend from claim 35, will also not be sustained.

Appellant's independent claim 50 requires "at least one hinge operable to couple an elongate member to a window frame" and "at least one joint operable to hingedly connect the plurality of frames." Even if we were to agree with the examiner that the double claw clips (155) of Richter provide a hinge or joint operable to hingedly connect the plurality of frames together, we remain of the view expressed above in our treatment

of claim 35, that the double claw clip does not define or provide a "hinge operable to couple an elongate member to a window frame" and that it would not have been obvious to modify the double claw clip (155) to do so. Accordingly, the examiner's rejection of claim 50 under 35 U.S.C. § 103(a) based on Richter will not be sustained. The examiner's rejection of claims 51 through 55, 57 and 59 through 66, which depend from claim 50, will also not be sustained.

As for independent claim 72, this claim defines a window shutter system that includes "at least one wall mount operable to couple the elongate members and the couplers to a surface." Again, it appears that the examiner has determined that the double claw clip (155) of Richter constitutes such a "wall mount." For the reasons generally expressed above, we do not agree that the double claw clip (155) would have been viewed by one of ordinary skill in the art as a "wall mount operable to couple the elongate members and the couplers to a surface." Nor has the examiner provided any explanation of exactly how the double claw clip of Richter is structurally and functionally capable of any such mounting/coupling of the elongate members to

a surface. Accordingly, the examiner's rejection of claim 72 under 35 U.S.C. § 103(a) based on Richter will not be sustained.

Method claim 67 is directed to a method for assembling a window shutter system wherein a plurality of elongate members and couplers are joined together to define at least one frame. The claim then sets forth the step of "attaching at least one hinge to the frame for mounting the shutter system to a window." While the examiner has urged that appellant's method represents nothing more than "the obvious method of assembling the Richter et al device," we do not agree. In the first place, we again point out that Richter is directed to panels or frames assembled together to define a room divider, not a window shutter system, and that the examiner has never addressed this difference. Moreover, since Richter is concerned with a room divider, not a window shutter system, it follows that there is nothing in Richter which teaches or suggests "attaching at least one hinge to the frame for mounting the shutter system to a window." Again we find that the examiner has failed to establish a *prima facie* case of obviousness, and for that reason, will not sustain the rejection of claim 67 under 35 U.S.C. § 103(a). It follows that the

examiner's rejection of dependent claims 68 through 71 will also not be sustained.

With regard to the examiner's alternative rejection of dependent claims 48 and 65 under 35 U.S.C. § 103(a) as being unpatentable over Turner '858 in view of Richter, the examiner has determined that it would have been obvious to modify the window shutter system of Turner '858 "whereby his couplers are replaced with the couplers of Richter et al since the Richter et al couplers permit adjustability of the angles between the elongate members, thereby expanding the design capabilities of the system" (final rejection, page 3). Like appellant, we find no basis in the combined teachings of Turner '858 and Richter for modifying the window shutter system of Turner '858 in the manner urged by the examiner. In that regard, we are of the view that the examiner is using the hindsight benefit of appellant's own disclosure to pick and choose elements from the applied references, and then selectively combine the chosen disparate elements in an attempt to reconstruct appellant's claimed subject matter. However, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780 (Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction

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manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

Moreover, even if such a substitution of coupling components were to be made, we do not see how this combination would result in the particular subject matter which is claimed by appellant in claims 48 and 65. Nor has the examiner provided any explanation of how one would arrive at the specific subject matter defined in claims 48 and 65 on appeal. Claims 48 and 65 are directed to a "hinge" of the type set forth in claim 1 or claim 50 on appeal as being operable to connect or couple an elongate member of a window shutter system to a window frame, and defines that hinge as further including "a hinge post and a wall mount." The examiner has simply not addressed the express limitations of dependent claims 48 and 65 specifically. Accordingly, we find that the examiner has not established a *prima facie* case of obviousness, and for that reason, will not sustain the rejection of claims 48 and 65 under 35 U.S.C. § 103(a) based on the combined teachings of Turner '858 and Richter.

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In view of the foregoing, the examiner's decision rejecting claims 35 through 40, 42, 44 through 55, 57 and 59 through 72 of the present patent application under 35 U.S.C. § 103(a) is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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Administrative Patent Judge)	INTERFERENCES
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